

**REMARKS/ARGUMENTS**

Reconsideration of the above-identified application in view of the present amendment is respectfully requested. By this amendment, claims 3, 4, 8, 9, 11, and 12 are amended and claims 13-16 are added. Claim 4 is submitted as the properly marked version in order to comply with 37 CFR 1.121(c)(2). Claims 3, 4, 8, 9, 11, and 12 are amended to replace the phrase "consist at least partially of" with --comprising-- or --comprises--, the phrase "consists of" with --comprising--or --comprises--, and the phrase "consisting at least partially of" with --comprising--. These amendments to these claims were not done to further distinguish over the cited references.

Claim 3 stands rejected as being anticipated by Schutz. This rejection is respectfully traversed. Schutz does not disclose or suggest detent elements comprising a multiple component plastic. The passage cited by the examiner at Col. 3, lines 52-60 of Schutz does not disclose or suggest detent elements comprising a multiple component plastic. In particular, the passage reads as follows:

"Of course, various modifications are conceivable for the construction of the contact surfaces. The pin 32, for example, can be metallic as shown and can have an insulation on the holding surface 42. Alternatively, it would also be conceivable to construct the pin 32 in plastic and to provide the contact surface 40 with a metallization. This would be particularly advantageous if the module housing 22 likewise consists of plastic, so that the pin 32 can also be molded on in one operating step."

No mention is made in Schutz of constructing a pin of a multiple component plastic. Schutz only discloses in this passage that either the pin 32 can be metallic as shown and can have an insulation on the holding surface 42, or the pin 32 can be

plastic and the contact surface be provided with a metallization. Schutz only discloses one plastic component in either of the above-mentioned versions.

Further, the objective of Schutz is to provide a horn contact on the detent connection. Actuation of the horn requires an electrical circuit to be closed. For actuation of the horn to occur, metallic contacts have to be in direct contact with each other. To accomplish this objective, Schutz only describes either a metal pin 32 having an electrically isolating material coated thereon to prevent undesired electrical contacts or a plastic pin being coated with a metal layer to provide electric contact with an electrically conductive counterpart. However, neither of these combinations is considered to be a multiple component plastic material, where the multiple component plastic comprises layers of different plastic materials. Schutz fails to disclose that the pins 32, which are alleged to be the detent elements, do not comprise a multi-component plastic.

Moreover, the Examiner's conclusion that the carrier consists of multiple component plastic because it is integrally formed with the detent elements is also not correct. In fact, having the pin molded on the carrier in one operating step as stated in Col. 3, lines 58-61 of Schutz is more conclusive that the carrier comprises only one plastic component. If the housing 22 and pin 32 of Schutz are molded in one operating step, the normal molding process would be to use a mold having shape of both the carrier and the detent pin, and then fill the mold with only one molten plastic material. Thus, both the carrier and detent pin would have to be the same material in order for the pin to be molded on the carrier in one step.

Furthermore, the Examiner alleges that the holding surface of Schutz is utilized to prevent the gas bag module from rattling and concludes that the holding

surface would necessitate a material that is less rigid than that of the pin to limit rattling and noise

However, the passage in column 3, lines 18-26, which the Examiner cites, discloses a completely different mechanism. In particular, the passage states as follows:

“Between the gas bag module 12 and the steering wheel skeleton 10, spring elements 56 are provided, which are illustrated in FIG. 1 as compression springs. The compression springs 56 exert a force on the gas bag module 12 so that the spring wire 52 lies free of play against the holding surface 42 when the horn is not actuated. With this, a basic position is established and the gas bag module 12 is prevented from rattling and causing disturbing noises whilst travelling.”

No reference is made to a special soft material on the holding surface 42 of Schutz to prevent rattling. Rather, the springs 56 prevent rattling of the gas bag module 12 by exerting a force on the gas bag module 12 so that the spring wire 52 lies free of play against the holding surface 42.

Schutz only describes that the holding surface 42 is electrically insulated from the pin 32, for example by a coating or disc of insulating material which is placed on it (see Col. 2, lines 50-52). No further properties are disclosed. The Examiner's conclusions are speculative.

The Examiner argues that because Schutz does not disclose that the holding surface is eliminated when making the pin of plastic, the plastic pin would still indicate that the holding surface is still required. This argument is not consistent with the objective of Schutz to provide a horn contact on the detent connection. Figures 2a and 2b, which the Examiner cites, show a metal detent pin 32 with an electrical

insulation on the holding surface 42. In fact, by providing a plastic pin 32 with an insulation, electrical contact between spring wire 52 and pin 32 would be prevented and thus, the principle operation of the invention would be affected. Such a design would be contrary to the stated objective of Schutz, which is to create an electrical contact between the spring wire 52 and detent pin 32.

Therefore, in view of the above-mentioned reasons, claim 3 is allowable. Claims 4, 5, and 7 depend directly or indirectly from claim 3 and are therefore allowable as depending from an allowable claim and for the specific features recited therein.

Claim 6 is allowable as depending from an allowable claim 7. In addition, claim 6 should be patentable over Schutz in view of Fischer for the following reasons. The M.P.E.P. sets forth the criteria for a rejection for obviousness under 35 U.S.C. §103 as follows:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

See, M.P.E.P. § 706.02(j) *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

There is no suggestion or motivation in Schutz or Fischer or in the knowledge of one of ordinary skill in the art to combine the reference teachings of Schutz and Fischer as proposed in the rejection of claim 6. The Office Action merely cites a

passage in Fischer that states that it would be obvious to do "so as to provide a steering wheel that is rugged, easy to manufacture, and easy to install". However, one of ordinary skill in the art will recognize that there is no need to modify Schutz to include the cover 24 of Fischer in the apparatus of Schutz in the manner taught by Fischer. In fact, the objective of Schutz is to provide a vehicle steering wheel with few components and a reduced installation expenditure (Col. 1, lines 18-20). However, to modify Schutz to include the cover 24 would be contrary to this objective, because of the addition of the cylindrical wall 30, which is integrally formed with the cover 24, to the steering wheel of Schutz. The mounting of the cylindrical wall 30 to the housing 22 would also increase the installation expenditure of producing the steering wheel Schutz. Further, Schutz specifically teaches against taking up portions of the already confined space in the vehicle steering wheel (Col. 1, lines 12-14). Yet, the cylindrical wall 30 of Fischer would take up additional space in the steering wheel of Schutz if included in the steering wheel of Schutz.

It is respectfully suggested that the obviousness rejection to claim 6 using Schutz and Fischer only seems plausible using hindsight after having the benefit of the Applicants' disclosure. The use of the teachings of the present invention to find obviousness is impermissible.

The court must be ever alert not to read obviousness into an invention on the basis of applicant's own statements; that is, we must view the prior art without reading into that art applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole obvious.

In Re Sponnoble, 160 USPQ 237 at 243 (CCPA 1969) (emphasis in original).

Accordingly, the Examiner must consider only the teachings of the prior art references. Without the teachings of the present invention, one of ordinary skill in the art would not even consider combining the teachings of Schutz and Fischer to attempt to arrive at the presently claimed invention. For the reasons set forth above, the rejection of claim 6 under 35 U.S.C. 103(a) fails to establish a prima facie case for obviousness, because there is no suggestion or motivation in Schutz or Fischer or in the knowledge of one of ordinary skill in the art to combine the reference teachings of Schutz and Fischer as proposed in the rejection of claim 6. Therefore, claim 6 is allowable for these additional reasons.

Claim 8 is allowable as depending from an allowable claim 7. In addition, claim 8 should be patentable over Schutz in view of Worrell et al. for the following reasons.

There is no suggestion or motivation in Schutz or Worrell et al. or in the knowledge of one of ordinary skill in the art to combine the reference teachings of Schutz and Worrell as proposed in the rejection of claim 8. There is no evidence in the record or in the references themselves to suggest including the container 18 and pad 20 of Worrell et al. in the apparatus of Schutz. The Office Action merely states that it would be obvious to do "so as to increase the outward appearance and feel". However, this reason is merely speculative. One of ordinary skill in the art will recognize that there is no need to modify Schutz to include the container 18 and pad 20 of Worrell et al. in the apparatus of Schutz in the manner taught by Worrell et al. In fact, the objective of Schutz is to provide a vehicle steering wheel with few components and a reduced installation expenditure (Col. 1, lines 18-20). However, to modify Schutz to include the container 18, pad 20, and fastener 22 used to bolt

the container 18 to the base plate 14, would increase both the number of components and installation expenditure to produce the vehicle steering wheel of Schutz. Further, Schutz specifically teaches against taking up portions of the already confined space in the vehicle steering wheel. Yet, the container 18, pad 20, and fastener 22 of Worrell et al. would take up additional space in the steering wheel of Schutz if included in the steering wheel of Schutz.

It is respectfully submitted that the obviousness rejection to claims 8 using Schutz and Worrell et al. only seems plausible using hindsight after having the benefit of the Applicants' disclosure, which is impermissible. For the reasons set forth above, the rejection of claim 8 under 35 U.S.C. 103(a) fails to establish a prima facie case for obviousness, because there is no suggestion or motivation in Schutz or Worrell et al. or in the knowledge of one of ordinary skill in the art to combine the reference teachings of Schutz and Worrell as proposed in the rejection of claim 8. Therefore, claim 8 is allowable for these additional reasons.

New claim 16, which depends on claim 8, should be allowed for the same reasons as claim 8 and also for the additional feature that the projecting section is one piece. Neither Schutz nor Worrell taken either alone or in combination discloses or suggests this feature. Therefore, claim 16 is allowable.

Claims 9 and 12 are amended to recite a covering cap that is a separate piece. Claims 9 and 12 patentably define over Adomeit et al. Adomeit et al. does not disclose or suggest this feature. Adomeit et al. shows a one piece module housing 5, which integrates the cover 5C and the generator support 10. Adomeit et al. states that this significantly reduces the number of components needed. Therefore, claims 9 and 12 are allowable. Claim 10, which depends from claim 9, is

therefore allowable as depending from an allowable claim and for the specific feature recited therein.

New claim 13, which depends from claim 12, should be allowed for the same reasons as claim 12 and also for the additional feature that the cover covers only the depression. Adomeit et al. does not disclose or suggest this feature. As seen in Fig. 1 of Adomeit et al., the cover 5C extends beyond the cover sidewalls 5W that surround the area of the generator 7. Therefore, claim 13 is allowable.

New claim 14, which depends on claim 9, should be allowed for the same reasons as claim 9 and also for the additional feature that the cover covers only the depression. Adomeit et al. does not disclose or suggest this feature. As seen in Fig. 1 of Adomeit et al., the cover 5C extends beyond the cover sidewalls 5W that surround the area of the generator 7. Therefore, claim 14 is allowable.

New claim 15, which depends on claim 10, should be allowed for the same reasons as claim 10 and also for the additional feature that the cover covers only the depression. Adomeit et al. does not disclose or suggest this feature. As seen in Fig. 1 of Adomeit et al., the cover 5C extends beyond the cover sidewalls 5W that surround the area of the generator 7. Therefore, claim 15 is allowable.

Claim 11 is amended to recite that the covering includes an upper portion that is flat and flushed with an upper portion of the rim of the depression. Claim 11 patentably defines over the prior art. Neither Fischer nor Schutz taken either alone or in combination discloses or suggests a cover of the gas bag module that includes an upper portion that is flat and flushed with a rim of depression of a generator carrier. Fischer shows a housing body 18 with a shallow depression in which a cylindrical wall 30 of the cover 24 is inserted. The upper flat portion of the cover 24



extends above and beyond the upper portion of the peripheral wall 28 of the housing body 18.

Further, neither Schutz nor Fischer taken either alone or in combination discloses or suggests a generator carrier comprising a multiple-component plastic. No mention is made in Schutz of constructing either the pin 32, which is alleged to be the detent element, or the housing 22, which is alleged to be the generator carrier, of a multiple component plastic. Schutz only discloses that either the pin 32 can be metallic as shown and can have an insulation on the holding surface 42, or the pin 32 can be plastic and the contact surface be provided with a metallization. Schutz only discloses one plastic component in either of the above-mentioned versions.

Also, the objective of Schutz is to provide a horn contact on the detent connection. Actuation of the horn requires an electrical circuit to be closed. For actuation of the horn to occur, metallic contacts have to be in direct contact with each other. To accomplish this objective, Schutz only describes either a metal pin 32 having an electrically isolating material coated thereon to prevent undesired electrical contacts or a plastic pin being coated with a metal layer to provide electric contact with an electrically conductive counterpart. However, neither of these combinations is considered to be a multiple component plastic material, where the multiple component plastic comprises layers of different plastic materials. Schutz fails to disclose that the pins 32 do not comprise a multi-component plastic.

Moreover, the Examiner's conclusion that the carrier consists of multiple component plastic because it is integrally formed with the detent elements is also not correct. In fact, having the pin molded on the carrier in one operating step as stated

in Col. 3, lines 58-61 of Schutz is more conclusive that the carrier comprises only one plastic component. If the housing 22 and pin 32 of Schutz are molded in one operating step, the normal molding process would be to use a mold having shape of both the carrier and the detent pin, and then fill the mold with only one molten plastic material. Thus, both the carrier and detent pin would have to be the same material in order for the pin to be molded on the carrier in one step.


In addition, there is no suggestion or motivation to modify Fischer with the teachings of Schutz. The office action cites no suggestion or motivation in Fischer or Schutz, or in the knowledge of one of ordinary skill in the art to combine the reference teachings of Fischer and Schutz as proposed in the rejection of claim 11. Therefore, the proposed combination of Fischer and Schutz fails to establish a prima facie case of obviousness. Therefore, in view of the above-mentioned reasons, claim 11 is allowable.

In view of the foregoing, it is respectfully requested that the amendment be entered

**Serial No. 10/690,236**

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Matthew M. Shaheen', written over a horizontal line.

Matthew M. Shaheen  
Reg. No. 45,367

TAROLLI, SUNDHEIM, COVELL,  
& TUMMINO L.L.P.  
1300 East Ninth Street, Suite 1700  
Cleveland, Ohio 44114  
Phone: (216) 621-2234  
Fax: (216) 621-4072  
Customer No.: 26,294